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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/136,483	08/19/1998	SUJEET KUMAR	2950.25US01	1810
<div>62274 7590 10/17/2007 DARDI & ASSOCIATES, PLLC 220 S. 6TH ST. SUITE 2000, U.S. BANK PLAZA MINNEAPOLIS, MN 55402</div> <div>EXAMINER MARCHESCHI, MICHAEL A</div> <div>ART UNIT PAPER NUMBER 1793</div> <div>MAIL DATE DELIVERY MODE 10/17/2007 PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/136,483	Applicant(s) KUMAR ET AL.	
	Examiner Michael A. Marcheschi	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8 and 11-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 17 and 18 is/are allowed.
6) ☒ Claim(s) 1-3, 5-8, 11-16 and 19-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claims 1-3, 5-8 and 19-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rostoker et al (U.S. Patent 5,389,194) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being obvious over Rostoker et al (U.S. Patent 5,389,194) in view of Farkas et al. (730) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 1-3, 5-8 and 19-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all the claims of copending Application No. 09/969,025 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 17 and 18 are allowed.

Applicant's arguments filed 8/1/07 have been fully considered but they are not persuasive.

The examiner acknowledges applicants remarks on the first 2 pages of the response filed 8/1/07, however, since these remarks do not amount to any issues raised with respect to how the art differs from the claimed invention, no further comment is necessary.

At most, applicants argue that they have shown un-refuted evidence that the Rostoker patent does not teach a process suitable for producing the claimed particle collections. This is

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not persuasive because applicants arguments are merely directed to process limitations, however the claims are directed to a composition. This line of argument would appear to be arguing that the particles taught in the Rostoker et al. patent are those of the Siegel et al. patent. The examiner disagrees because Rostoker et al. does not state that this is the only method of making the particles, but rather uses the Siegel et al. reference as showing a known **possible** method. Rostoker et al. does limit the method to the Siegel et al. method, as apparently argued by the applicants. Applicants are apparently ignoring the teachings in Rostoker that define that the particles have the claimed distribution. With all due respect, where in the Rostoker patent is it stated that the particles therein are only produced using the method of Siegel? The examiner is unable to find any passage relating to this. As for the declarations previously submitted, the declarations have been fully considered, alone and in combination, as outlined in many of the office actions previously supplied by the office and the comments thereof are incorporated herein by reference.

In summary, (1) the examiner has clearly rebutted all of applicants positions taken and thus the evidence relied upon by applicant is not un-refuted and (2) the examiner is unclear as to how arguments directed to a process would provide evidence of patentability to a collection of particles especially since (a) applicants are not claiming a process and (b) the particles of Rostoker are not necessarily produced by the method of Siegel. It would appear that applicants are primarily focusing on the production method, however, the claims are not defined in terms of a method. In view of this, any arguments pertaining to the method are irrelevant and the claims are interpreted in view of the size requirements only. The fact that the examples (of Rostoker) do not say how to obtain the particles within the taught ranges does not establish that methods

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for making the particles are unknown because they must have been made. A reference does not require specific disclosure of what is already known to one of ordinary skill in the art. *Case v. CPC International Inc.* 221 USPQ 196, 201 (Fed. Cir. 1984). In view of this, the reference clearly enables the invention disclosed therein.

With respect to the 103 rejection of Rostoker et al. in view of Farkas et al., applicants are arguing Farkas alone, and not in combination, as applied, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to the ODP (obvious double patenting rejection) based on 09/969,025, applicants argue that the ODP rejection is not proper apparently because the instant application has filing date of 8/19/98 and the copending application has a date of 10/1/01. Any arguments presented against this rejection are not persuasive because the purpose of an ODP rejection and a subsequent terminal disclaimer is also to establish common ownership though out the life of any patented granted from the applications defined in the rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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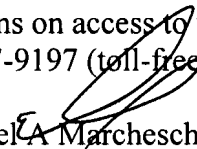
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM


Michael A. Marcheschi
Primary Examiner
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